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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,511	02/13/2004	Eric H. Carter	MS306136.01 / MSFTP549US	8912
27195 7590 04/03/2008 AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			EXAMINER NGUYEN, VAN H	
			ART UNIT 2194	PAPER NUMBER
			NOTIFICATION DATE 04/03/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/779,511	<b>Applicant(s)</b> CARTER ET AL.	
	<b>Examiner</b> VAN H. NGUYEN	<b>Art Unit</b> 2194	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 24-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. Applicant's election of group I (claims 1-23), filed 12/21/2007 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-38 are pending in this application. Applicant is required to cancel non-elected claims 24-38 in the next response to this office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims recite “a computer implemented system” in the preamble only, the body of the claims *merely contains software components*. Therefore, the claims are software per se and do not fall within one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

### Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by **Herrmann** (US 5995756 A).

**As to claim 1:**

Herrmann teaches a computer implemented system that facilitates processing of a document, comprising: a host application that facilitates creation of the document; and a programming component that at least one of embeds code in the document and links code to another document such that the document can be run independently of the host application (see the Abstract; col.3, line 31-col.4, line 17; col.5, line 8-col.10, line 25; see also, Figs.1-5).

**As to claim 2:**

Herrmann teaches the document runs on a client and a server (see Figs.1-5 and the associated text).

**As to claim 3:**

Herrmann teaches the programming component facilitates scaling by providing more features when the document is running on a client and fewer features when the document is running on a server (col.5, line 8-col.10, line 25).

**As to claim 4:**

Herrmann teaches the programming component separates document information into data content and view content (col.3, line 31-col.4, line 17; and col.16, line 53-col.7, line 11).

**As to claim 5:**

Herrmann teaches the view content maps programmable names to generic API objects, which objects are exposed as view controls that can be programmed against (col.3, line 31-col.4, line 17; col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 6:**

Herrmann teaches data content acts indirectly against the view content via data binding (col.12, line 54-col.15, line 40).

**As to claim 7:**

Herrmann teaches the programming component generates a data island in the document that is accessible by a client and a server (col.3, line 31-col.4, line 17; col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 8:**

Herrmann teaches the programming component automatically generates a data island in the document that conforms to a predetermined data schema and can be edited without the full host application running (see Figs.2-5 and the associated text).

**As to claim 9:**

Herrmann teaches the programming component is event based such that the code runs according to an event that is related to a client or a server (col.12, line 54-col.15, line 40).

**As to claim 10:**

Herrmann teaches generates a runtime exception when a system error occurs (col.12, line 54-col.15, line 40).

**As to claim 11:**

Herrmann teaches controls permissions associated with the document according to whether the document is running on a client or a server (col.3, line 31-col.4, line 17; col.5, line 8-col.10, line 25).

**As to claim 12:**

Herrmann teaches the code includes data code portions of which are attributed to indicate if the corresponding data can be run on a client, a server, or both (col.3, line 31-col.4, line 17; col.5, line 8-col.10, line 25).

**As to claim 13:**

Herrmann teaches a computer (see Fig.1A-1B).

**As to claim 14:**

Herrmann teaches the use of computer readable medium (see Fig.1A-1B).

**As to claim 15:**

Herrmann teaches system that facilitates processing of a document, comprising: a host application that facilitates creation of the document; and a data component that facilitates creation of a data island that is at least one of embedded in the document and linked to from another document (see the Abstract; col.3, line 31-col.4, line 17; col.5, line 8-col.10, line 25; see also, Figs.1-5).

**As to claim 16:**

Herrmann teaches the data island can be edited by running only a subset of components of the host application (col.3, line 31-col.4, line 17; col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 17:**

Herrmann teaches the data island can be accessed and modified on a server without having to start the host application (col.3, line 31-col.4, line 17; col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).



**As to claim 18:**

Herrmann teaches the data island is synchronized with document contents when the document is run inside the host application (col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 19:**

Herrmann teaches a data model that is connected to the data island to work directly against data of the data island (col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 20:**

Herrmann teaches the data island is synchronized with document contents when the document is run inside the host application, and changes to the data model are moved into the document contents via a data binding mechanism (col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 21:**

Herrmann teaches data of the data island can be cached by marking the data using an attribute (col.9, line 65-col.10, line 11; and col.16, line 53-col.7, line 11).

**As to claim 22:**

Herrmann teaches the document is one of an OLE structured document, an XML file, and a binary file that facilitates storing a persisted state of cached data, wherein if the document is a binary file, a reader/writer of the host application can be employed to insert the data island into the binary file and which reader/writer can be used to edit the data island (col.12, line 54-col.15, line 40).

**As to claim 23:**

Herrmann teaches the OLE document is processed on either a client or a server, the cached data can be reconstituted out of the OLE document, manipulated, and changes to the cached data stored back into the OLE document (col.12, line 54-col.15, line 40).

### **Response to Arguments**

4. Applicant's arguments filed 12/21/2007 have been considered but are moot in view of the new ground(s) of rejection.

### **Contact Information**

5. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MENG-AI AN can be reached at (571) 272-3756.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/VAN H NGUYEN/  
Primary Examiner, Art Unit 2194**

Application/Control Number: 10/779,511  
Art Unit: 2194

Page 11